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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,887	08/20/2003	Paul E. Jacobs	000373D1	8187
23696 7590 07/18/2007 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 07/18/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com  
kascanla@qualcomm.com  
nanm@qualcomm.com

## Office Action Summary

Application No.

10/645,887

Applicant(s)

JACOBS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/12/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 5/1/2007.
2. Claims 1-58 are presented for examination.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh) in view of Montague (6,298,332 hereinafter Montague).

With respect to claims 1, 4, 7, 9-10, 13-19, 24, 27, 31, 34-40, 45-50 Marsh teaches a computer readable medium including instructions stored thereon for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network (Abstract). Instructions for downloading advertisements from at least one remote source, during one or more advertisements download sessions (see figure 4,item 601); instructions for storing the downloaded advertisements on a storage medium associated with the client device (col. 14, lines 1-10); instructions for displaying at least selected ones of the stored advertisements on a display associated with the client device while use of a program (Figure 6, 702); instructions for compiling audit function that compiles as-related statistical data relating

to the downloaded advertisements, wherein the ad-related statistical data includes display event-related data regarding advertisements that were displayed during a prescribed audit interval (col. 14, lines 66-, col. 15, lines 1-7); instructions for transmitting an audit data transmit function that transmits the ad-related statistical data to a prescribed server system (Figure 8 and col. 15, lines 10-20).

Marsh teaches sending the statistical data to the server (Figure 8 and col. 14, lines 66-, col. 15, lines 1-20). Marsh teaches instructions for restricting access to the program based on the audit data (i.e. the use of the free e-mail program is based on the amount of time spent interacting with the ad. The user receives free-email based on reading and clicking on the ads, if the user doesn't read or click on enough ads then the use/time of the free e-mail program will be restricted or limited in time)(col. 9, lines 28-40 and col. 14, lines 66 to col. 15, lines 1-20).

With respect to transmitting the audit data to a server only in response to a user granting permission to do so. Montague teaches delivering vendor-supplied information from a purchase, the purchaser authorizing transmission of various data to a vendor server or a third party server (col. 9, lines 20-24). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Marsh the teaching of Montague of sending the data only in response to a user's grant permission to do so because such a modification would allow the users to have control of the data that is transmitted.

With respect to claims 2-3, 25-26 Marsh further teaches that the prescribed

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rollover intervals correspond to the prescribed audit intervals (col. 3, lines 12-27 and col. 7, lines 7-24).

With respect to claims 5 and 28, Marsh further teaches under a client policy transmitting a statistical sampling of a population of client devices, at prescribed times (col. 3, lines 12-27 and col. 7, lines 7-24).

Claims 6 and 29 further recite transmitting to random ones of population of client devices at prescribed times. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the audit at random times in order to obtain the above mentioned advantage.

With respect to claims 8 and 32, Marsh further teaches that the audit data further includes user demographic data (col. 3, lines 12-27).

With respect to claims 20, 41 Marsh further teaches that the advertisement distribution server system is managed by a producer of the software (col. 3, lines 12-56).

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With respect to claims 11-12, 21, 32-33, 42, Marsh further teaches that the advertisement distribution server system is managed by a distributor of the software (col. 3, lines 12-56).

With respect to claims 22, 43, Marsh further teaches that the communication network is the Internet (Figure 8, 107).

With respect to claims 23, 44, Marsh further teaches that the software is e-mail software (see Figure 8).

With respect to claims 51 and 53, Marsh further teaches that advertisement display function effects display when the client device is offline (col. 6, lines 63-, col. 7, lines 1).

With respect to claims 52, 54 Marsh further teaches that the advertisement display function effects display while the user is composing/reading e-mail messages (col. 7, lines 1-6).

Claims 55-58 further recite that the audit data is transmitted at activated random times. Marsh teaches transmitting audit data (col. 14, lines 66-, col. 15, lines 1-7). Marsh does not specifically teach transmitting the audit data at random times. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary

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skill in the art at the time of Applicant's invention to have included transmitting the audit at random times in order to obtain the above mentioned advantage.

**Response to Arguments**

4. The 101 and 112 rejections have been withdrawn.
5. Applicant argues that the references do not teach restricting the use of the program based on the usage data. The Examiner disagrees with Applicant because Marsh teaches the use of the free e-mail program is based on the amount of time spent interacting with the ad. The user receives free-email based on reading and clicking on the ads, the system keeps track of the time spent watching ads, if the user doesn't read or click on enough ads then the use/time of the free e-mail program will be restricted or limited in time (col. 9, lines 28-40 and col. 14, lines 66 to col. 15, lines 1-20).

**Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

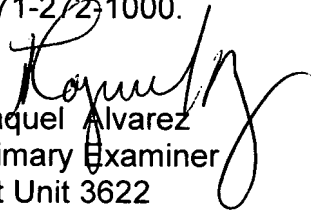
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Raquel Alvarez  
Primary Examiner  
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R.A.  
6/29/2007